

**REMARKS/ARGUMENTS**

These remarks are made in response to the Final Office Action of August 12, 2004 (Office Action). As this response is timely filed within the three-month shortened statutory period, no fee is believed due.

In paragraph 7-8 of the Office Action, claims 1, 5-11, 13, 14, 16, 19, 20 and 22-23 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,026,156 to Epler, *et al.* (Epler). In paragraph 9-10, claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Epler in view of U.S. Patent No. 5,559,860 to Mizikovsky. In paragraph 11, claims 12, 15, and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Epler in view of U.S. Patent No. 6,108,630 to Kuechler *et al.* (Kuechler) and further in view of U.S. Patent No. 5,930,501 to Neil.

In response, independent claims 1, 7, 14, and 20 have been amended to clarify an embodiment of the present invention. More specifically, the claims previously stated that an on-line interface can be provided through which the participant can associate distinctive ring tones with calling parties. Applicants intended the term on-line to be defined as a Web-enabled interface. The Examiner, however, has expressed that Epler discloses an interface 58 through which a user can associate distinctive tones, which the Examiner has interpreted as an on-line interface. To clarify Applicants' intended meaning, Applicants have amended claims 1, 7, 14, and 20 to replace the term "on-line" with "Web-enabled." Support for these amendments can be found at page 8, lines 11-20 of the Applicants' specification. No new matter has been added.

In paragraph 2-4 of the Office action the Examiner stated that the affidavits filed on

March 1, 2002 were insufficient to change the date of invention of the current application under 37 C.F.R. § 1.131, as insufficient detail to prove conception and diligence was provided.

A brief review of the case history to this stage may be helpful. In the reply of May 26, 2004, Applicants included executed Declarations under 37 C.F.R. § 1.131 supporting the removal of U.S. Publication No. 2002/0146107 to Baals (Baals) as a reference. The Examiner provided no indication of whether the 37 C.F.R. § 1.131 Declarations were accepted in the second office action, as noted in the Applicants' reply of May 26, 2004. In the present Office Action, the Examiner stated that the presented Declarations and remarks were insufficient to show conception and diligence.

Presently, the Examiner has not relied upon Baals in the Office Action, yet would still be able to utilize Baals as a reference against the present invention, since a change in the invention date has not been granted. Applicants herein traverse the Examiner's rejection of the 37 C.F.R. § 1.131 Declarations previously submitted by providing additional proof of conception and diligence (as detailed below) and supported by the accompanying Declarations.

In response to the Office Action, Applicants have enclosed the Declarations under 37 C.F.R. § 1.131 supporting the removal of Baals as a reference. The Declarations are accompanied by a copy of the Applicants' Confidential Invention Disclosure No. BOC8-2001-0004 (Disclosure) entitled "Fancy Caller ID Tones" The Disclosure and Declarations demonstrate proof of conception for the claimed subject matter of the Applicants' invention at least as early as February 12, 2001, which predates the effective date of Baals (April 10, 2001).

The Disclosure represents the completion of an internal International Business Machines

Corporation (IBM) confidential disclosure form, which is a standardized document utilized by IBM and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the Disclosure once the Disclosure has been completed. Any changes and/or additions are appended as an attachment to the IBM confidential disclosure form together with the date the attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since Feb 12, 2001.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art. The present application, including each claim within the present application, has been prepared based upon the Disclosure. Further, as noted in the enclosed Declarations, prior to submission of the application to the USPTO, the inventors reviewed the application to insure that the claims and material contained therein are fully supported by the Disclosure.

For example, the concept from which the legal limitation "receiving from a calling party, over a telephony connection, call information comprising a specified telephone number of the user in the existing telephone call and at least one of a user name and password" was based upon the Disclosure. This limitation as expressed in the claims was generated by outside counsel from the material contained within the Disclosure without reliance on additional inventive materials, as could have been performed by any skilled patent attorney based upon the material contained

within the Disclosure. Moreover, the accompanying Declarations signed by the inventors certify that the claimed material for the present invention was contained within the Disclosure.

Applicants further exercised due diligence from prior to the effective date of Baals until March 1, 2002, the filing date of the instant application. In regard to diligence, as set forth in the Declarations, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application. Instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the application sufficiently details the inventive concepts detailed in the disclosure, at which time the application is expeditiously filed with the USPTO.

Since Applicants conceived of the present invention before the effective date of Baals and exercised due diligence in constructively reducing the invention to practice between the date of the Disclosure until the filing date, as supported by the enclosed Declarations, Baals should be withdrawn as a reference and the Applicants date of invention should be established as February 12, 2001, which action is respectfully requested.

In paragraph 7-8 of the Office Action, claims 1, 5-11, 13, 14, 16, 19, 20 and 22-23 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Epler. Epler discloses a method and system for providing enhanced call waiting telephony functions. In particular, Epler discloses a system where an interrupting party to an established telephone call can be prompted

with a courtesy message asking the interrupting party to select one of a plurality of available options for handling the call.

As amended, independent claims 1, 7, 14, and 20 now include a feature relating to providing a Web-enabled interface through which the participant can associate distinctive ring tones with calling parties. This allows the subscriber to go on-line using an interface to the World Wide Web and enter caller names and other information and associate those callers with particular distinctive call waiting tones. This allows a subscriber to manage his or her own enhanced call waiting service via the Web or Internet.

The Examiner has conceded that Epler does not teach or suggest this functionality in paragraph 8 of the office action mailed February 26, 2004, which states "Epler fails to teach that a selection is made through an Internet Connection." Instead, the only interface that Epler teaches is a telephone (10, 11, 12 of FIG. 1) that conveys voice signals to the telephone switch 20. Moreover no structure is contemplated by Epler that would allow for a selection to occur via a Web-enabled interface, which is simply not contemplated by Epler.

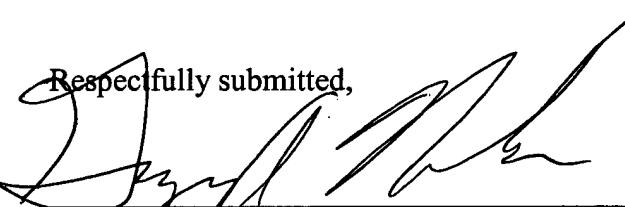
Because Epler does not teach or suggest a Web-enabled interface through which parties can associate distinctive ring tones with calling parties, Epler does not anticipate the Applicants claimed invention. Accordingly, the 35 U.S.C. § 102(e) rejection with regard to claims 1, 5-11, 13, 14, 16, 19, 20 and 22-23 should be withdrawn, which action is respectfully requested.

Regarding the 35 U.S.C. § 103(a) rejection of claims 3, 12, 15, 18, 21, and 25, neither Mizikovsky, Kuechler, Neil, nor any combination thereof teaches or suggests the Web-based

interface feature of the Applicants' invention. As such, the Applicants believe that these claims are allowable due, at least in part, to their dependency upon independent claims 1, 7, 14, and 20.

The Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

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Respectfully submitted,  


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